

### Remarks

Reconsideration of the application is respectfully requested.

Claims 11-20 were rejected in the Office Action mailed January 18, 2007, and claims 1-10 and 21 were allowed. Accordingly, claims 1-21 remain pending in the application.

### Claim Rejections under 35 U.S.C. § 103

In "Claim Rejections – 35 USC § 103" item 2 on page 2 of the above-identified Office Action, claims 11-20 have been rejected as unpatentable over U.S. Patent No. 6,675,353 to *Friedman* (hereinafter "*Friedman*") in view of "the applicant's choice of specific programming instructions stored on the storage device" under 35 U.S.C. § 103(a).

First, Applicants respectfully submit that "the applicant's choice of specific programming instructions stored on the storage device" is not a proper reference for a rejection under 35 U.S.C. §103(a). While explicitly admitted prior art in the originally filed specification may be the basis for a §103 rejection, no other portion of the specification is to be construed as prior art. Applicants firmly deny that the "specific programming instructions" cited by the Examiner are explicitly admitted prior art. Thus, the rejection of claims 11-20 must stand or fall based on whether *Friedman* teaches or suggests the claimed limitations.

On pages 2-3 of the Office Action, the Examiner notes that *Friedman* teaches a processing unit and a storage unit. The Examiner then refers to the "specific programming instructions" cited above as a mere "choice of design", and states that such instructions may be stored on the storage unit of *Friedman*.

Applicants fully agree that *Friedman* teaches storage and a processor. The issue is whether the recitations of the "specific programming instructions" stored on

the storage and operated by the processor are statutory subject matter that comprise limitations of the invention of claim 11. This issue was before the Federal Circuit and was definitively resolved in the case of *In re Alappat*, 33 F.3d 1525 (Fed. Cir. 1994). There, the court held that an implementation of a computer program in a general purpose computer is statutory subject matter. *Id.* Because claim 11 recites a computer program (i.e., "specific programming instructions") implemented in a computer (apparatus having storage and a processor), those instructions are properly viewed as statutory subject matter, and thus comprise limitations of a claimed invention.

Because the "specific programming instructions" are properly construed as limitations, they must be taught or suggested by Friedman. Nothing in Friedman teaches or suggests the instructions, however. In fact, claim 1, which recites a method having operations implemented by the "specific programming instructions," is allowed by the Examiner in the instant Office Action. If claim 1 is allowable over Friedman, the specific programming instructions of claim 11 cannot be taught or suggested by Friedman. As previously stated, claim 11 is simply claim 1 in apparatus form.

Accordingly, claim 11 is patentable over Friedman under §103(a).

Claims 12-20 depend from claim 1, incorporating its limitations. Thus, for at least the same reasons, claims 12-20 are patentable over Friedman under §103(a).

#### Allowed Claims

In item 3, on page 3 of the above-identified Office Action, the Examiner allowed claims 1-10 and 21. Applicants thank the Examiner.

#### Conclusion

In view of the foregoing, allowance of all pending claims is solicited. Applicants submit that both allowed claims 1-10 and 21 and rejected claims 11-20

are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: February 27, 2007

by: /Robert C. Peck/

Robert C. Peck  
Reg. No.: 56,826

Schwabe, Williamson & Wyatt, P.C.  
Pacwest Center, Suites 1600-1900  
1211 SW Fifth Avenue  
Portland, Oregon 97222  
Telephone: 503-222-9981